REMARKS

In the November 4, 2004 Office Action, claims 11, 12, 14, 18, 19 and 36-41 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner objected to the Applicants' use of "said selection of program material" in claims 11, 14 and 18.

Additionally, all pending claims were rejected under 35 U.S.C. § 103(a). Claims 11, 12, 14, 15, 26, 27, 29, 30, 36-39 and 44-45 were rejected as allegedly obvious over U.S. Patent No. 5,905,942 to Stoel et al. (hereinafter "Stoel") in view of U.S. Patent No. 5,931,901 to Wolfe et al. (hereinafter "Wolfe") and further in view of U.S. Patent No. 5,581,270 to Smith et al. (hereinafter "Smith"). Claims 18, 19 and 41 were rejected as allegedly being obvious over Stoel in view of U.S. Patent No. 5,781,734 to Ohno et al. (hereinafter "Ohno") further in view of Smith. Claim 40 was rejected as allegedly being obvious over Stoel in view of Ohno and Smith and further in view of Wolfe. Applicants respectfully traverse all rejections of record.

Remarks in Response to Rejections under 35 U.S.C. § 112

Claims 11, 12, 14, 18, 19 and 36-41 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner objected to the Applicants' use of the phrase "said selection of program material" in claims 11, 14 and 18. By the foregoing amendment, Applicants have amended claims 11, 14 and 18 to correct informalities and clarify the scope of the claimed invention. All claim amendments are supported by the specification. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be removed.

Remarks in Response to Rejections under 35 U.S.C. § 103(a)

Independent claim 11 as amended is directed to a method for presenting program material from a plurality of program sources to users using a host computing device and allocating tasks among a plurality of audiovisual serving devices, said method comprising, *inter alia*:

> responding to a user request to order program material by selecting one of a plurality of Assignable Computing Devices, said selected Assignable Computing Device being used to generate a menu listing available program material;
>
> presenting the user with said menu over a Room Communication Subsystem;
>
> presenting the program material to the user over the Room Communication Subsystem
>
> wherein said menu listing available program material is generated for display in a web browser and may be customized based on said user preferences.

Stoel and the other cited references are fundamentally different from the present invention for at least the following reason. Stoel and the other cited references do not disclose or even remotely suggest generating a menu using an Assignable Computing Device. As noted by the Examiner on p. 4 of the Office Action, "Stoel does not explicitly disclose the selected assignable computing device being used to generate the menu." The Examiner refers to the newly-cited Smith reference as allegedly disclosing this feature of the claimed invention. Applicants respectfully disagree.

Smith refers to a video game/communications system which permits a user in a guest room to access video games or other services. (*See* Smith, Abstract). In the system described by Smith, each guest room includes a terminal device which is coupled

to the guest's color television and to a game controller. "By pressing a game controller menu key, the guest room guest initiates the downloading of applications software by the host computer to the array of SNES engines *located within the guest room.* A downloaded applications program generate [sic] a display menu which appears on the guest's television." (Smith, Abstract (emphasis added)). Importantly, the SNES engines described by Smith are local, i.e., located *within the guest room.* Accordingly, these SNES engines are *not* "Assignable Computing Devices," as recited in the claims of the present invention, since these SNES engines are not assignable to other users - they are operational for a given guest in a given room. Moreover, Smith nowhere discusses de-assignment of a SNES system, which suggests that the system of Smith is not like the system of the claimed invention which is directed to the use of "Assignable Computing Devices." For at least these reasons, Applicants respectfully submit that all pending claims of the application are now in condition for allowance.

Additionally, claim 11 as amended recites that the "menu listing available program material is generated for display in a web browser." Other independent claims include similar limitations, or provide that the menu is generated at least using some form of HTML (HyperText Markup Language) code. The Smith patent fails to disclose or suggest generation of a menu to be viewed in a browser or using HTML code. In fact, the menu of the Smith patent is generated using a SNES system, which accordingly teaches away from use of a browser interface or HTML code. For at least this additional reason, Applicants respectfully submit that all pending claims of the application are now in condition for allowance.

Furthermore, as noted in the portion of Smith cited by the Examiner, "any

one of the SNES engines (1 to N), the host computer 7 or the guest terminals (2) may be programmed to control the generation of menu displays." (Smith, col. 7, lns. 41-43). As noted above, the SNES engines do not disclose or suggest the claimed limitation of an "Assignable Computing Device being used to generate a menu listing available program material." For the same reasons as stated above, a guest terminal/set-top box which generates a menu also fails to disclose or suggest this limitation. Finally, Smith describes a third alternative for generating a menu - using the host computer 7 to generate a menu. However, as addressed previously in this application with respect to the Stoel reference, a headend unit or host computer is *not* an "Assignable Computing Device." Accordingly, because the Smith reference does not disclose or suggest an "Assignable Computing Device being used to generate a menu listing available program material," and further because the Examiner has admitted the Stoel and the other cited references also fail to disclose or suggest this feature, Applicants respectfully request that the claims as amended be allowed

Additionally, Applicants disagree with the Examiner's combination of the newly-cited Smith reference with the Stoel reference and other cited references. The Examiner's purported motivation to combine Smith with Stoel is that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Stoel by selecting any one of SNES engines to generate a menu as taught by Smith in order to efficiently provide menu in which a wide range of available items may be selected by the subscriber." (Office Action, p. 4). However, this motivation to combine the references would not exist, since Stoel already describes generating interactive menus to aid in the selection of program content (*See, e.g.,* Stoel,

col. 10, lns.61-65), albeit using the headend unit (as opposed to generating menus using an assignable computing device, in accordance with the claimed invention). Accordingly, there would be no reason for one skilled in the art viewing the Stoel reference to look elsewhere "to modify the system of Stoel by selecting any one of SNES engines to generate a menu as taught by Smith in order to efficiently provide menu in which a wide range of available items may be selected by the subscriber." (Office Action, p. 4). Applicants therefore respectfully submit that the Examiner's combination of references is improper. For at least this additional reason, Applicants respectfully requests that the claims be allowed.

Moreover, as noted in the Office Action and previous Office Action, Stoel fails to disclose creating a set of user data listing stated user preferences, as required in claims 11, 12, 14, 15, 26, 27, 29, 30 and 36-45. The Examiner asserts that Stoel can properly be combined with Wolfe to describe such feature. Applicants again respectfully traverse this assertion.

Wolfe is directed to a system and method for delivering programmed music and targeted advertising to internet subscribers. (*See* Wolfe, Abstract). The provision of targeted advertising is a distinct endeavor from the multiple dwelling unit cable television system for distribution of television programming and interactive services described in Stoel. Furthermore, there is no teaching or suggestion to combine these references in any of the cited art. Absent some teaching, suggestion, or incentive supporting the combination, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention. (*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933, 732 F.2d 1572, 1577 (Fed. Cir. 1984)). Accordingly, Applicants

respectfully submit that this combination of references is improper. For at least this additional reason, Applicants respectfully submit that pending claims 11, 12, 14, 15, 26, 27, 29, 30 and 36-45 are in condition for allowance.

Furthermore, the invention of claim 11 as amended also recites that "said menu listing available program material may be customized based on said user preferences." Customization of the list of program material presented to the user, as claimed in the context of the present invention, is not disclosed or suggested in the references cited. For at least this additional reason, Applicants respectfully submit that at least claims 11, 12, 14 and 15 are in condition for allowance.

In addition to the foregoing comments, Applicants incorporate fully by reference all Remarks submitted in response to the previous Office Actions entered in this application.

CONCLUSION

In view of the foregoing amendments and remarks, favorable consideration and allowance of all pending claims 11, 12, 14, 15, 18, 19, 26, 27, 29, 30 and 36-45 are respectfully solicited.   In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,

Paul A. Ragusa
PTO Reg. No. 38,587
(212) 408-2588

Robert L. Maier
PTO Reg. No. 54,291
(212) 408-2538

Attorneys for Applicants

BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112